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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,551

12/08/2003

Todd K. Whitehurst

AB-308U

4571

23845 7590 02/22/2007
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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT

PAPER NUMBER

3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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30 DAYS

02/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



18
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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20070216

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

~ C
George R Evanisko
Primary Examiner
Art Unit: 3762

2/16/16

DETAILED ACTION

Response to Amendment

The reply filed on 11/17/06 is not fully responsive to the prior Office Action because:

The applicant has not provided a complete reply to the 1.105 requirement for information.

The Examiner asked the applicant to state what nerves the applicant considers the intercostal nerve branches to consist of. The applicant replied that the nerves are the intercostal nerve branches and nothing more. Specifically, on page 2 of the arguments, the applicant stated that the terms and meanings are not being provided because they are so defined in the originally filed specification, that the nerves are so identified in the ordinary and customary terminology of the art, and that the meaning of the claimed terms is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. This is not persuasive. First, the Examiner is requiring the applicant to point out in the specification (page and line number) where the names of these nerves are provided. A reply that only points out terms such as "intercostal" or "intercostal nerve branches" will be held non-responsive. Second, since these nerves and branches are ordinary and customary terminology and since a person of ordinary skill in the art would give the nerves their ordinary and customary meaning, the applicant will have no difficulty in providing the names of these nerves (specific names, keywords, etc) since they are ordinary and customary.

The applicants argument on page 3 that to provide any other definition for the nerves and branches at this point in the examination would be the introduction of new matter is not persuasive. The intercostal nerves and branches are somewhat set in humans. Although some

Art Unit: 3762

people may not have all the branches, unless evolutionary changes in the human are going to take place in the next 20 years (or have occurred since filing), the number and/or names of these nerves and branches have been designated. In addition, it would be inherent that the applicants supplied names of these nerves and branches are in the specification since these nerves and names ARE the intercostal nerves and branches.

The argument on page 4 that the request made does not appear reasonably necessary to properly examine or treat the application is not persuasive. The Examiner who is examining an application is the judge of what information he requires necessary to examine the application. As set forth in the Requirement mailed 9/18/06, the Examiner explained why the Requirement was necessary.

The argument on page 4 that the application can be properly examined using the normal and established procedures of the US Patent Office is correct and supports the Examiners position that the Requirement is proper and necessary. A Requirement for Information is a normal and established procedure. See MPEP 704.

The argument on page 4 that 37 CFR 1.105 does not include an example requiring the applicant to give a supplemental definition to a claim term or defining the scope of a prior art search is not persuasive. 37 CFR 1.105 specifically states that the Examiner may require information, for example “[T]echnical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability...”. In addition, the MPEP states that interrogatories can be made, such as “the meaning of claim limitations or terms used in the claims, such as what teaching in the prior art would be covered

Art Unit: 3762

by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term...”.

The applicant on page 5 also fails to provide information requested, such as keywords, for searching/locating references for the intercostal nerves and intercostal nerve branches (which is basically the overall request to provide the names of the branch nerves). Although the applicant stated that the “obvious answer” is stimulation, intercostal nerve, or branch, this does not appear to be a bona fide attempt to provide keywords. Such terms as “lateral cutaneous branch”, “rami cutanei laterales”, “thoracic intercostal nerve”, etc. are examples of the definitions/names for the nerves and branches that should be provided.

Since the period for reply set forth in the prior Office action has expired, this application will become **abandoned** unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. **A fully responsive reply must be timely filed to avoid abandonment of this application.**

Art Unit: 3762

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George R Evanisko
Primary Examiner
Art Unit 3762

2/16/06

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